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OFFICE OF PETITIONS

In re Application :
De Lignieres, et al. :
Application No. 10/734,640 : PATENT TERM ADJUSTMENT
Filing or 371(c) Date: December 15, 2003 :
Dkt. No.: 088734-1111 :

This is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705," filed March 23, 2010. This matter is being properly treated under 37 CFR 1.705(b) as an application for patent term adjustment.

Applicants submit that the correct patent term adjustment to be indicated on the patent is 943 days, not 381 days as calculated by the Office as of the mailing of the initial determination of patent term adjustment mailed February 2, 2010. Applicants request this correction on the basis that the Office will take in excess of three years to issue this patent. Applicants further indicate that the period of applicant delay under 37 CFR 1.704 is 347 days rather than 374 days as calculated by the Office.

37 CFR 1.702(b)

Insofar as the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is DISMISSED as PREMATURE.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See, § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent based on the initial determination of patent term adjustment and a projected issuance date of the patent (or

even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and **must** include payment of the required fee under 37 CFR 1.18(e).

37 CFR 1.704(b)

Applicants herein do not acknowledge the reduction of 27 days pursuant to 37 CFR 1.704(b) in connection with the filing of the request for continued examination filed September 25, 2008. However, the adjustment is properly reduced 27 days, the reduction having commenced August 30, 2008 and ended September 25, 2008.

In view thereof, the request for correction of the reduction of is DISMISSED.

CONCLUSION

Accordingly, for the reasons set forth herein, no adjustment to the patent term adjustment will be made.

The \$200.00 patent term adjustment application fee required per 37 CFR 1.705(b)(1) has been charged to the authorized deposit account.

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3205.

/ALESIA M. BROWN/

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